## REMARKS

The Office Action dated 03/01/2004 (hereinafter referred to as the OA) has been received, and its contents carefully studied. Applicant presents this response and amendment which Applicant believes to be fully responsive to the OA. Applicant, in the interest of making progress in the general prosecution of the pending application, has made various amendments to currently pending claims. Applicant reserves the right to present, or re-present, material Applicant believes to be patentable subject matter not covered in the presently pending claim set except such material that is expressly and explicitly disclaimed by Applicant herein, in future applications or correspondence with the US Patent Office.

### Claims Rejections Under 35 USC § 102

Independent claims 134, 135, 137, 138, 139, 147, 151 and 152 have been rejected as anticipated by Weiss (US Patent 6,165,071).

Weiss does not teach each of the limitations found in the presently pending independent claims. Applicant has amended the pending claims to make clear Applicant's use of the limitation "restriction" as it is used with each alternate choice of: a time restriction, a location restriction, or a gaming device restriction (found in each of the independent claims). The presently claimed invention requires that for each of the alternate restrictions (time, location, or gaming device) there be a subset of machines that can use the restriction, but not all (expressed as the limitation of "subset"). Put differently, the presently claimed invention has a set of gaming machines on which at least one of the restrictions is usable, and further requires that a subset of the gaming machines be selectable as machines to which the restriction(s) will apply from the overall set to which they could be applied. Weiss does not teach this. Weiss' sports game information is discussed in the disclosure as usable on any machine compatible with the sports data (4:51-64). Weiss has no concept or teaching of enabling a subset of compatible machines to be restricted, while other compatible machines are not.

The OA stated that Weiss teaches the concept of a set of machines on which a themed game could be played (Applicant agrees), and that Weiss further teaches being able to restrict play to a subset of those machines (Applicant disagrees). There is no teaching in Weiss to this capability of the presently claimed invention. All Weiss discusses is the ability to use one theme (such as baseball) on either a machine that can play any of his sports-themed games (i.e., baseball, basketball, etc.), or, all single-purpose machines (i.e., machines for use with baseball only). The presently claimed invention has concepts not taught by Weiss, specifically including the ability to only use data on a subset of otherwise eligible gaming machines. This concept, expressed in Weiss' terms, would be as if Weiss was teaching that a baseball data card would not be useable in some baseball-themed machines, but usable in others. Weiss, to the contrary, wants his sports-themed cards to be usable in any data-compatible machine.

As to time restrictions, Applicant wishes to note that it is being asserted that because a person using the Weiss machines may start and stop play on a machine, that is the same as the restrictive time element of the presently claimed invention. Applicant believes this to be incorrect, as discussed in detail in Applicant's previous response. The presently claimed invention allows or disallows a player to make use of newprom data on a gaming machine based on time; the player has no control. This is the opposite of what Weiss teaches, where it is entirely up to the player (there are no time restrictions on a player's ability to play Weiss' sports-themed games).

Applicant is unable to find the claimed limitations as to the ability to use a subset of compatible gaming machines based on a time restriction, a location restriction, or a game device restriction, in Weiss. Applicant respectfully requests specific cites to these claimed elements in Weiss if the Examiner disagrees with Applicant and believes the elements are there.

Applicant believes that for at least the above discussed reasons, the presently claimed invention is not anticipated by Weiss.

In addition to the elements just discussed above, the presently claimed invention has additional functional elements not taught by Weiss. The presently claimed invention also has the

functional element that an enhancement (game or award) be combined with a restriction. The presently claimed invention (the presently pending claims) have a conjunctive between the restrictions (time, location, or gaming machine) and the enhancements (game play or award). Weiss also does not teach this functional element.

Obviousness Under 35 USC § 103

In order to further prosecution, Applicant wishes to add that Applicant believes the presently claimed invention is also not made obvious by Weiss. Each pending independent claim, 134, 135, 137, 138, 139, 147, 151 and 152, has elements not taught by Weiss (restrictions as to time, location, or game machine), and has functional relationships not taught by Weiss (at least one restriction combined with at least one enhancement as to a subset of data compatible gaming machines). Further, Applicant can find no teaching in the cited art to modify Weiss in a manner that yields the presently claimed invention. If the Examiner disagrees, Applicant respectfully requests cites in Weiss to these teachings.

Applicant must respectfully respond to an assertion made towards the end of the OA. Applicant understood the comments made at the bottom of page 4 and the top of page 5 of the AO to be that all gaming machines are the same ("The Examiner takes this as an admission that the system can be practiced on any gaming machine and thus ... the arguments are moot"). If it appears that Applicant misunderstood the Examiner in this paragraph, Applicant apologizes beforehand. Continuing respectfully, the OA appears to say that the Applicant has "admitted" all gaming machines are the same, so therefore all the Applicant's arguments about claims limitations are moot. The underlying assertion is not correct; further, Applicant was unable to follow the logic that leads to the statement that Applicant's claims arguments are moot based on that assertion (correct or not).

Applicant's disclosure spends a great deal of space explaining different savable game states and the different games to which they may or may not apply. For example, see the description of the transportable game states associated with Figures 12, 13 and 15, which give

various examples of different kinds of states, including but not limited to those currently addressed in the pending claims. The disclosure further discusses that different types of game state are usable on gaming machines that "understand" (are compatible with) the feature associated with that type of state. Pages 34 and 35 describe two examples of bonus games that have savable game state usable with gaming machines that have either the same bonus games, or bonus games that have the same state representation (i.e., for figure 12 it could be a gaming machine with a secondary bonus game having the same number of steps to get to the bonus, with similar paytables, but graphically showing a monkey climbing tree branches rather than a frog hopping on lily pads, etc.). This clearly does not apply to every gaming machine. Thus, Applicant must respectfully disagree that Applicant has made any type of admission that somehow all gaming machines are fungible as to all restrictions and enhancements.

Applicant also disagrees that Applicant's statements about time, location, or gaming machine restrictions and game play or award enhancements are made moot in any case. Even if, arguendo, the disclosure could be construed as allowing the use of a system in accordance with the inventive concepts found therein with any gaming machine ever made, Applicant cannot see how that makes discussions about the claimed elements moot. As is the case with patents generally, the presently claimed elements may or may not cover all the territory found in the disclosure. In the present situation, the presently pending claims cover only a portion of the disclosure. The fact that the disclosure discusses more area than is presently claimed does not make discussions of the presently pending claims' elements moot.

Pending Dependent Claims 136, 140-142, 145, and 150

As each of the presently pending dependent claims inherits the limitations of the independent claims from which it eventually depends, for at least the same reasons as discussed above, each of the pending dependent claims is not anticipated or made obvious by Weiss.

## CONCLUSION

The applicant believes the presently pending claims are in condition for allowance. Applicant respectfully requests consideration for allowance thereby.

Respectfully submitted,

Dated:

Russ F. Marsden
Reg. No. 43,775

Alliance Gaming Corp.
Sierra Design Group
6601 S. Bermuda Rd.
Las Vegas, NV 89119
(702) 896-7930